

REMARKS

Applicants have received an Office communication mailed May 27, 2008. The communication pertains to the Amendment After Final Action filed January 30, 2009, entry of which was requested by a Request for Continued Examination filed March 2, 2009. Specifically, the communication states that the Amendment After Final Action is non-responsive because it presents claims directed solely to a non-elected invention. In response, Applicants now submit this Amendment. Applicants note that, under the practice set forth in MPEP § 821.03, the non-responsive Amendment After Final Action, which requested the cancellation of claims 1, 2, 4, and 9-11 and the addition of several new claims, will not be entered. Thus, the listing of the claims now amended is the listing presented by the Amendment filed June 23, 2008.

This application has been reviewed in light of the above-mentioned communication and the Office Action dated September 30, 2008. Claims 12-17 are newly presented for examination, with claims 12 and 15 being independent. Claims 1, 2, 4, and 9-11 have been canceled without prejudice or disclaimer of the subject matter previously presented in those claims. New claims 12-17 have been added to provide Applicants with a more complete scope of protection. Support for these amendments may be found throughout the originally-filed disclosure including, for example, at paragraphs [0105]-[0107] of the specification. Thus, no new matter has been added. Applicants respectfully request favorable reconsideration.

Initially, Applicants submit that the new claims are readable on the elected invention. In particular, the new independent claims recite recording a record of a transaction in a secondary transaction number (STN) profile associated with a non-

currency-based account. Applicants note that their presentation of new claims is not a concession that the previously-submitted claims in the Amendment After Final Action were not readable on the elected invention.

Claims 1, 2, 4, and 9-11 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Because these claims have been canceled, the rejection is rendered moot. However, Applicants considered the grounds for the rejection in presenting their new claims. On this point, Applicants note that the method recited in independent claim 12 includes identifying a non-currency-based account via a computer of the provider and generating a secondary transaction number at a remote server of the provider. The method of claim 12 thus is at least tied to the positively-recited computer and the positively-recited remote server. Therefore, the method is patent-eligible process within the meaning of § 101. Applicants further note that independent claim 15 recites a computer-readable program product comprising a computer-readable storage medium. A computer-readable storage medium is properly characterized as a machine or manufacture under § 101. Thus, claim 15 also is patent-eligible.

Claims 1, 2, 4, and 9-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to recitations of “a non-currency-based cash equivalent amount.” Again, cancellation of these claims renders the rejection moot. Applicants note that the allegedly indefinite recitation does not appear in the new claims.

Turning now to the art rejections, claims 1, 2, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,689,100 to *Carrithers et al.* (*Carrithers*) in view of Applicants’ specification, the background section of which the Office Action considers to admit certain teachings as prior art. Claims 4 and 11 were

rejected under § 103(a) as unpatentable over *Carrithers* in view of Applicants' specification and in further view Official Notice and U.S. Patent No. 5,537,314 to *Kanter* (*Kanter*). Without conceding the propriety of these rejections, Applicants have canceled these claims and added new claims 12-17. Applicants submit that new independent claims 12 and 15, together with the claims depending from them, are patentably distinct from the cited art for at least the following reasons.

The Office Action relies mainly on *Carrithers* to teach a method for facilitating a non-currency-based transaction. However, the Office Action admits that *Carrithers* fails to teach a STN. For a teaching of a STN, the Office Action relies on the background section of Applicants' specification. That section discusses temporary transaction numbers in the general context of secure transactions. However, nothing in that section teaches or suggests several features recited by claim 12, including generating a STN that is associated with a non-currency based account, creating a STN profile including information relating to a cash equivalent amount available to the STN, auto-filling the STN into a transaction request provided to a merchant, and receiving a transaction authorization request that includes the STN. Therefore, Applicants submit that claim 12 is patentable over any combination of the background section of their specification and, as the Office Action admits, *Carrithers*.

The secondary citation to *Kanter* and the statements of Official Notice at page 3 of the Office Action fail to compensate for the deficiencies in the art discussed above. Neither *Kanter* nor the statements even contemplate a STN, much less any of the particular features recited in claim 12. Thus, claim 12 is patentable over all of the cited art,

whether that art is taken alone or in combination. Accordingly, Applicants submit that claim 12 recites allowable subject matter.

Independent claim 15 recites a computer program product comprising a computer-readable storage medium. Tangibly embodied in the storage medium is control logic comprising computer-readable program codes having features similar to those discussed above with respect to claim 12. Thus, the reasoning set forth there is applicable here. Accordingly, Applicants further submit that claim 15 is allowable.

The remaining claims depend directly from either claim 12 or claim 15. Thus, these claims are patentable for at least the same reasons. Moreover, because each dependent claims defines additional aspects of the invention, Applicants respectfully request individual consideration of the patentability of each dependent claim on its own merits.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office communication is deemed necessary for this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 50-3939.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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